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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,977	01/17/2002	Akira Date	500.37453CX1	6853

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EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2615

DATE MAILED: 06/07/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,977

Applicant(s)

DATE ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/369,401.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-3 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-7 of U.S. Patent No. 6,493,504

B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 1 of this application, claim 3 of U.S. Patent No. 6,493,504 recites a storage medium wherein a still picture (VOB) is recorded, having still picture group management information (VOBGI) for managing one or more still pictures (VOB) as a still picture group (VOBG), wherein:

said still picture group management information (VOBGI) is classified into types of still picture management information including:

a first type of still picture management information (V_I) on a still picture with no audio to be reproduced in synchronism with the reproduction of the still picture,

a second type of still picture management information (V_OA_I) on a still picture with only an original audio recorded substantially at the same time the still picture was record,

a third type of still picture management information (V_AA_I) on a still picture with only a post recorded audio added to the still picture already recorded, and

a fourth type of still picture management information (V_OA_AA_I) on a still picture with both of the original audio and a post-recorded audio added to the still picture already recorded, and said still picture group management information (VOBGI) includes still picture management information (VOBI) having an identifier which indicates said type; and

said storage medium causes a playback apparatus for playing back the still picture recorded in said storage medium to execute the following process according the said identifier with said still picture management information (VOBI) of the still picture to be played back, said process includes a step of playing back only the still picture if said identifier is a first identifier, plying back the still picture with the original audio if said identifier is a second identifier, playing back the still picture with the post-recorded audio if said identifier is a third identifier, or playing back the still picture with either of the original audio and the post-recorded audio if said identifier is a fourth identifier. It is

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obvious to one of ordinary skill in the art to recognize that the storage medium of claim 3 of U.S. Patent No. 6,493,504 B1 can be created by the method of claim 1 of this application or that the method of claim 1 of this application can create the storage medium of claim 3 of U.S. Patent No. 6,493,504 B1.

Regarding claim 2 of this application, claims 3-4 of U.S. Patent No. 6,493,504 B1 recite the claimed wherein said first still type of picture management information includes identification information for identifying said first type of still picture management information and size information of image data of the still pictures corresponding to said first type of still picture management information.

Regarding claim 3 of this application, claims 3 and 5 of U.S. Patent No. 6,493,504 B1 recite the claimed wherein said second still type of picture management information includes identification for identifying said second type of still picture management information, size information of image data of the still pictures corresponding to said second type of still picture management information, and an original audio playback time.

Regarding claim 4 of this application, claims 3 and 6 of U.S. Patent No. 6,493,504 B1 recite the claimed wherein said third type of still picture management information includes identification information for identifying said third type of still picture management information, size information of image data of the still picture corresponding to said third type of still picture management information, and pointer information for providing a link to a post-recorded audio data of the still pictures corresponding to said third type of still picture management information.

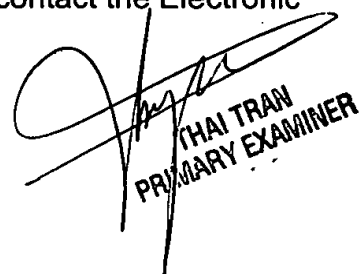
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Regarding claim 5 of this application, claims 3 and 7 of U.S. Patent No. 6,493,504 B1 recite the claimed wherein said fourth type of still picture management information includes identification information for identifying said fourth type of still picture management information, size information of image data of the still pictures corresponding to said fourth type of still picture management information, size information of original audio data of the still pictures corresponding to said fourth type of still picture management information, an original audio playback time and pointer information for providing a link to a post-recorded audio data of the still pictures corresponding to said fourth type of still picture management information.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THAI TRAN
PRIMARY EXAMINER